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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,862	07/20/2001	Hong Xue	3053.1000-001	8767

21005 7590 03/30/2004

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/909,862

**Applicant(s)**

XUE ET AL.

**Examiner**

Shengjun Wang

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 29, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16, 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt of applicants' amendments and remarks submitted December 29, 2003 is acknowledged.

#### ***Claim Rejections 35 U.S.C. 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-16 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassels et al. (US 5,756,538, IDS) for reasons set forth in the prior office action.

#### ***Response to Applicants' Arguments***

Applicants' amendments and remarks submitted December 29, 2003 have been fully considered, but are not persuasive for reasons discussed below.

3. Applicants contend that the examiner has not established a prima facie case of obvious simply because the examiner did not follow the procedure in MPEP to consider all the Graham factors. The arguments are not convincing. In the prior office action, the examiner states "Cassels et al teaches a method of treating anxiety comprising administering to the patient an effective non-toxic amount of substituted flavonoid, particularly substituted flavone, wherein the substituents may be hydroxyl group or low alkyl alkoxyl groups. Cassels particularly prefer flavone wherein the 5, and 7 positions have hydroxyl substituents. See, particularly, the claims (*the scope and contents of the prior art*).

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4. Cassels et al. does not teach expressly the employment of the flavone herein with R4 is a methoxyl groups (*the different between the claimed invention and the prior art*).

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to treat anxiety by employing a flavone with hydroxyl groups at 5, and 7, and a methoxyl group at 8 position (R4 as depicted by Cassels). A person of ordinary skill in the art would have been motivated to treat anxiety by employing a flavone with hydroxyl groups at 5, and 7, and a methoxyl group at 8 position (R4 as depicted by Cassels) because Cassels expressly prefer flavone with 5 and 7 dihydroxyl groups and methoxyl group is known to be useful as a substituent at 8 position (R4) (*object evidence of obviousness*). The selection of methoxyl group herein is seen to be a selection from amongst equally suitable functional groups and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388). Further, the optimization of a result effective parameter, e.g., the effective amount of a therapeutical agent, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215 (*level of ordinary skill in the art*).

In response to applicant's argument that there is no express teaching or motivation to reach the particular subject matter herein claimed, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion or motivation is found both in the prior art and in the knowledge generally available to one of ordinary skill in the art.

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Particularly, “the selection of methoxyl group herein is seen to be a selection from amongst equally suitable functional groups and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388).” Further, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278.

Therefore, a prima facie case of obviousness has been established. Applicants further contend that it is incorrect to assume that “The selection of methoxyl group herein is seen to be a selection from amongst equally suitable functional groups,” but fails to provide any factual evidence showing Wogonin is different from those disclosed by Cassels. It is applicants’ burden to show that wogonin provides unexpected benefit as compared with the flavonoids disclosed by Cassels. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant’s burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.1323 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See, MPEP 716.02 (e).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

**SHENGJUN WANG**  
**PRIMARY EXAMINER**



Shengjun Wang

March 27, 2004